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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,403	06/06/2005	Andreas Turberg	LeA 35598	2152
7590	09/18/2008		EXAMINER	
Richard S Bullitt Bayer Corporation 36 Columbia Road Box 1910 Morristown, NJ 07962-1910				KASSA, TIGABU
		ART UNIT	PAPER NUMBER	4161
			MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/511,403	TURBERG ET AL.	
	Examiner	Art Unit	
	TIGABU KASSA	4161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 2 is/are pending in the application.
 - 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1 and 2 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/6/05</u> . | 6) <input type="checkbox"/> Other: ____ . |

DETAILED ACTION

Status of the Claims

Claims 1-2 are currently pending and are the subject of this Office Action. This is the first Office Action on the merits of the claims.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The information disclosure statements (IDS) submitted on 06/06/2005 was noted and the submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner has considered the information disclosure statement.

Claim Rejections - 35 USC § 112

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 provides for the use of the use of phenylketoenol derivatives of the general formula (I) as recited in the instant claim, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lieb et al. (US Patent No 6,114,374).

Applicant Claims

Applicant claims the use of the use of phenylketoenol derivatives of the general formula (I) as recited in the instant claim. In other embodiments, such as instant claim 2, recites a method for controlling parasites in animals and in their environment, in which a suitable amount of active compound of the formula (I) as claimed in claim 1 is applied to the animals.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Lieb et al. disclose 2-and 2,5-substituted phenylketoenol derivatives having the generic structure recited in the instant claim (see claim 1). Lieb et al. disclose within the disclosed genus several species, such as the single product obtained from the reaction of 3-[(2-chloro-5-methyl)-phenyl]-4-hydroxy-5,5-tetramethylene- Δ^3 -dihydro-furan-2-one and ethyl isocyanate as starting

materials (see column 36, lines 1-25). This reaction product, which represents one of the compounds invented by Lieb, reads on Applicants' recited genus of formula I.

Lieb et al. disclose that the invented compounds are suitable for the control of both animal and plant pests, such as scab mites and trombiculid mites (column 56, line 29). It is noted that scab mites and trombiculid mites are pests that infect animals, such as domestic animals and humans. Lieb et al. disclose that the active compounds are suitable for controlling animal pests for example from the order acarina (column 52, line 38).

*Ascertainment of the Difference Between Scope the Prior Art and the Claims
(MPEP §2141.012)*

Lieb et al. does not explicitly teach a specific compound to be used in the method for controlling parasites in animals and in their environment. Lieb et al. discloses a list of compounds and methods of preparing and uses of these compounds are also listed.

*Finding of Prima Facie Obviousness Rationale and Motivation
(MPEP §2142-2143)*

It would have been prima facie obvious to utilize one of Lieb's invented compounds, such as the compound disclosed in column 36, lines 1-25, to control mites and other pests, because Lieb teaches that the invented compounds are suitable for the control of mites and other pests. An ordinary skilled artisan would have been motivated to utilize Lieb's invented compounds to control mites, because said compounds are taught by Lieb as being suitable to control mites. Thus, an ordinary skilled artisan would have had a reasonable expectation of

successfully controlling mites by application of Lieb's invented compounds, such as the compound specified in (column 36, lines 1-25). "

Conclusion

Claims 1-2 are rejected. No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TIGABU KASSA whose telephone number is (571)270-5867. The examiner can normally be reached on 9 am-5 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tigabu Kassa 9/12/08

/Mina Haghigian/
Primary Examiner, Art Unit 1616